

compatible with industry standards in order to support an inherency rejection based on this reference. It is insufficient to simply state that it is inherent that some apparatuses are compatible with standards.

The alleged inherent feature of claim 34 recites a case with “a form factor including a plurality of external dimensions compatible with an industry standard having a plurality of specifications governing the form factor and the external dimensions.” Examples of Pokharna’s portable computer system 202 are given as a notebook computer, a tablet computer, and a laptop computer. The varying shapes and sizes of these computers belie any inherent teaching of compatibility with an industry standard that governs the form factor and external dimensions of portable computer systems.

Because there is no basis to support a reasonable determination that a Pokharna inherently discloses a case that is compatible with an industry standard as recited in claim 34, an anticipation rejection of claim 34 based on this reference is improper.

Claims 2 – 3, 6 – 8, 11 – 12, 25, 27, and 37 depend from, or include limitations similar to, claim 34. Therefore, these claims are also patentable over this cited reference.

#### **Claim Rejections – 35 USC § 103(a)**

Claim 4 is rejected under 35 USC § 103(a) as being unpatentable over Pokharna in view of Katooka et al. (US 5,424,915) (hereinafter “Katooka”). Claim 4 has been cancelled without prejudice rendering this rejection moot.

Claims 9 – 10, 13 – 16, and 35 are rejected under 35 USC § 103(a) as being unpatentable over Pokharna. The Applicants traverse these rejections.

These claims ultimately depend upon claim 34. As discussed above, Pokharna fails to teach the elements recited in claim 34 and therefore these claims are patentable over Pokharna for at least the above given reasons.

These claims also add additional points of patentability. For example, with respect to claims 15 – 16, the Examiner has conceded that Pokharna fails to teach that the apparatus forms a PC card for use as a data storage device or a communication adapter. However, the Examiner goes on to state that “it has been held that recitation

with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987)."

In *Ex parte Masham* (hereinafter "*Masham*") the court held that the claim term "completely submersed in the developer material" did not impose any structural limitations upon the claimed apparatus which differentiated it from the asserted prior art. That is, claiming an operating environment in which a structure may be used will not distinguish it from an equivalent structure found in prior art.

Contrary to *Masham*, the limitation at issue in claims 14 and 15 does provide structural limitations, i.e., that the listed elements form a PC Card. It is clear from the present specification as would be understood by a person skilled in the art that a PC Card is not the structural equivalent of a portable computing device as defined by Pokharna. Therefore, the portable computing device of Pokharna does not satisfy the claimed structural limitations of claims 14 and 15.

With respect to claim 35, the Examiner states that while Pokharna does not disclose at least one partition connected to the board "it would have been obvious ...to combine the partition and the board into a single element, since it has been held as obvious of one skilled in the art ... to make two separate elements integral. *In re Larson*, 340 F.2d 965, 968 (CCPA 1965) (hereinafter "*Larson*").

The partition defined in claim 35 provides a plurality of air flow chambers (as previously defined in claim 11). Therefore, even assuming the Examiner can interpret the board 204 to be both the board and the partition of claim 35, the "partition" of Pokharna does not provide a plurality of air flow chambers. There is no airflow above the board 204 and therefore this cannot be said to be an airflow chamber. The only arguable airflow chamber other than the one in which the actuation membrane 208 is disposed, is at the bottom inlet 210. At best, these plurality of airflow chambers are provided by the partition at the left of the inlet 210; however, this partition is not connected to the board 204.

For at least these reasons, these claims are also patentable over Pokharna.

In the Office Action, claims 30 – 33, 36, and 38 are rejected under 35 USC § 103(a) as being unpatentable over Suzuki et al. (US 6,031,718) (hereinafter “Suzuki”) in view of Pokharna. Furthermore, claims 18 – 23 are rejected under 35 USC § 103(a) as being unpatentable over Suuzki in view of Pokharna and further in view of Katooka et al. (US 5,424,915) (hereinafter “Katooka”). Claims 18, 30 – 33, and 38 have been cancelled without prejudice rendering their rejections moot. The Applicants traverse the remaining rejections.

The embodiment of Suzuki depicted in Fig. 17 is alleged to have all of the elements of claim 36 except for a flow generating device. Pokharna is relied upon to teach this missing element.

Above amendments are presented to clarify that the inlet and outlet vents are disposed on the same surface. Because neither Pokharna nor Suzuki teach, suggest, or imply this element, claim 36 is patentable over this combination.

With respect to claim 18, the Examiner stated that the combination of Suzuki, Pokharna, and Katooka disclose all of the elements including that the inlet and outlet vents are on the same surface. While 18 has been cancelled, rendering this rejection moot, this asserted combination will be discussed with respect to claim 36.

There is insufficient motivation to combine these references in a manner to make claim 36, as a whole, obvious. Pokharna teaches a mobile computing device. Katooka teaches a power supply device. Suzuki teaches an IC card. Without the benefit of the teachings of the current application, one skilled in the art would not have the motivation or direction required to successfully modify the IC card of Suzuki to include the flow generating device of Pokharna implemented with the airflow plan (including inlet and outlet on same surface) of Katooka.

The motivation for the airflow plan of Katooka lies in the fact that power supply devices are arranged with chambers in a vertically stacked orientation. The lower chamber has devices that do not generate heat. The upper chamber includes devices that generate heat, some of which may be conductively transferred to the lower chamber. The small amount of heat from the lower chamber does not justify having its own flow generating device. Therefore, the flow generating device used for the upper

chamber is also utilized to provide airflow through the bottom chamber. Thus, the motivation for including the vents on the same surface lies in the desire for cooling the two chambers with one device.

Suzuki, on the other hand, only includes one chamber that includes the heat generating components. Therefore, there is nothing to motivate modifying Suzuki to include an inlet and an outlet on the same surface as was done in Katooka.

In the present application, the novel features of providing the inlet vent and the outlet vent on the same surface allows for operation of the peripheral apparatus within confined operating environments, e.g., when the peripheral apparatus is inserted into a host. This may facilitate the intake and exhaust being directed towards areas of the ambient that can disperse the heat, e.g., into an internal airflow of the host or outside of the host.

The Examiner makes a reference to one being motivated to co-locate inlet and outlet vents on the same surface when the remaining surfaces are blocked by the operating environment. However, there is nothing in Suzuki or the art in general to identify this blockage as a problem for which a solution would be desirable. In fact, the airflow arrangements presented in Suzuki are assumed to be sufficiently functional without said co-location of vents. Furthermore, there is nothing in Katooka that would suggest that the co-location of vents is for the purposes of addressing this blockage problem. As discussed above, this co-location of vents is to address a different problem altogether.

For at least these reasons, combination of the cited references in the proposed manner is improper. Therefore, claim 36 is patentable over these references.

Claims 19 – 23 depend from claim 36 and are patentable over these references for at least the same reasons as given above.

### **Conclusion**

Applicant respectfully submits that the claims 2, 3, 6 – 16, 19 – 23, and 34 – 37 are presented in allowable form. Accordingly, a withdrawal of remaining rejections and issuance of a Notice of Allowance is respectfully requested.

If the Examiner has any questions, he is invited to contact the undersigned at (503) 796-2972.

The Commissioner is hereby authorized to charge shortages or credit overpayments to Deposit Account No. 500393.

Respectfully submitted,  
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